REMARKS

Claims 1-29 are pending in the present application. Claims 1, 6, 12-26 and 28 have been amended. New claims 30-32 have been added. New Claims 30-31 are supported by block 122 in Fig. 1 and p. 7, lines 1-5 of the specification. New Claim 32 is supported by p. 6, paragraph 1016.

Allowable Subject Matter

Applicant thanks the Examiner for allowing Claims 22-25 and indicating Claims 14, 18 and 28-29 would be allowable if rewritten as independent claims. Claims 14, 18, and 28 have been rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 29 depends from Claim 28.

Rejection of Claims 1-3, 5-9, 11-12, 16, 20-21 and 26 Under 35 U.S.C. § 102(b)

The Office Action rejected claims 1-3, 5-9, 11-12, 16, 20-21 and 26 under 35 U.S.C. § 102(b) as being anticipated by International Patent Application Publication No. WO 99/49690 to Magnusson (hereinafter "Magnusson").

Applicant respectfully traverses this rejection. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicant respectfully submits that claims 1-3, 5-9, 11-12, 16, 20-21 and 26 are patentably distinct from Magnusson. Magnusson does not disclose all limitations in these claims.

With respect to claim 1, Magnusson does not disclose a "processor configured to detect when a wireless mobile unit is in a high data rate area" (emphasis added). Page 2 of the Office

Action states that "Magnusson teaches ... receiving/storing data from cell broadcast to include information about an HDR area." Applicant respectfully disagrees.

The portion of Magnusson cited by the Office Action states:

> The network which is controlled by the base station 1 can recommend which carrier services that can be used optimally on each given occasion, but the actual decision is always taken by the mobile equipment 2, 3. ... [T]he information which is transmitted on Cell Broadcast is received by the mobile terminal 2 and is stored on the SIM-card. This information includes information about the <u>momentary allocation of resources</u> of the network and <u>loading locally</u> for just that cell where the information has been received.

Magnusson, page 5, line 16 – page 6, line 12 (emphasis added). However, receiving "information about the momentary allocation of resources of the network and loading locally" does not disclose or suggest "detect[ing] when a wireless mobile unit is in a high data rate area," as recited in claim 1. Detecting "when a mobile unit is in a high data rate area" does not depend on "the momentary allocation of resources of the network" or "loading locally." Rather, detecting "when a mobile unit is in a high data rate area" depends on the physical location of the mobile unit and/or the capabilities of a wireless communication system in which the mobile unit is located.

In addition, Claim 1 has been amended to recite "a data burst optimizer configured to exchange said data between said wireless mobile unit and said base station <u>when the processor detects said wireless mobile unit is in said high data rate area</u> and <u>the processor determines a need for exchanging data between the wireless mobile unit and the base station</u>." Magnusson does not disclose this limitation.

For the reasons stated above, Applicant respectfully submits that claim 1 is patentably distinct from Magnusson.

Claims 2-3 and 5 depend either directly or indirectly from claim 1. Accordingly, Applicant respectfully submits that claims 2-3 and 5 are allowable for at least the same reasons presented above for claim 1.

In addition, with respect to claim 2, Magnusson does not disclose invoking a "data burst optimizer to exchange said data between said wireless mobile unit and said base station when said wireless mobile unit is in said high data rate area." Page 3 of the Office Action states that

Magnusson teaches a "system selecting the optimal carrier service, eg. HDR, based on the application chosen."

The portion of Magnusson cited by the Office Action states:

> When the user of the mobile terminal 2 shall start an application which requires a data connection, a request is made to the SIM-card which can recommend a carrier service which is an optimal choice with regard to selected application and resource allocation and loading in the network.

Magnusson, page 5, lines 30-35 (emphasis added). Magnusson, however, does not state that the "carrier service which is an optimal choice" is "high data rate" (HDR), as recited in claims 1 and 2. Magnusson lists the following factors that influence how a carrier service is selected:

> The problem is to know how to select right carrier service with regard to traffic model which in its turn is influenced by how the application is designed and how the customer uses this application.

> What further complicates the matter is that the optimal selection of carrier service also is influenced by how the resources in the network are allocated and how they are loaded.

Magnusson, page 4, lines 19-26 (emphasis added). None of these factors disclose or suggest selection of a carrier service that is configured to transfer data "in a high data rate area," as recited by claims 1 and 2. Thus, this is another reason why claims 1 and 2 are patentably distinct from Magnusson.

With respect to claim 6, Magnusson does not disclose "means for detecting when a wireless mobile unit is in an HDR area." Magnusson also does not disclose "means for exchanging said data between said wireless mobile unit and said base station when the wireless mobile unit is in said high data rate area and there is a need for exchanging data between said wireless mobile unit and a base station," as recited in Claim 6. These differences between claim 6 and Magnusson were discussed above with claim 1. Accordingly, Applicant respectfully submits that claim 6 is patentably distinct from Magnusson.

Claims 7-9 and 11 depend from claim 6. Accordingly, Applicant respectfully requests that the rejection of claims 7-9 and 11 be withdrawn for at least the same reasons presented above for claim 6.

With respect to claim 12, Magnusson does not disclose "detecting when said wireless mobile unit is in a high data rate area." Magnusson also does not disclose "exchanging said data

between said wireless mobile unit and said base station when said wireless mobile unit is in said high data rate area." These differences between claim 12 and Magnusson were discussed above. Accordingly, Applicant respectfully submits that claim 12 is patentably distinct from Magnusson.

Claim 16 depends indirectly from claim 12. Applicant respectfully requests that the rejection of claim 16 be withdrawn for at least the same reasons presented above for claim 12.

Claims 20-21 depend either directly or indirectly from claim 17. With respect to claim 17, Magnusson does not disclose "detecting when [a] wireless mobile unit is in a high data rate area." Magnusson also does not disclose "exchanging said data between said wireless mobile unit and said base station when said wireless mobile unit is in said high data rate area." These differences between claim 17 and Magnusson were discussed above. Accordingly, Applicant respectfully submits that claims 20-21 are patentably distinct from Magnusson.

With respect to claim 26, Magnusson does not disclose "detecting when [a] wireless mobile unit is in a high data rate area." Magnusson also does not disclose "exchanging said data between said wireless mobile unit and said base station when said wireless mobile unit is in said high data rate area." These differences between claim 26 and Magnusson were discussed above. Accordingly, Applicant respectfully submits that claim 26 is patentably distinct from Magnusson.

Rejection of Claims 4, 10, 13, 15, 17, 19, and 27 Under 35 U.S.C. § 103(a)

The Office Action rejected claims 4, 10, 13, 15, 17, 19, and 27 under 35 U.S.C. § 103(a) based on Magnusson.

Applicant respectfully traverses this rejection. The M.P.E.P. § 2142 states:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.
>
> The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter,

either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Applicant respectfully submits that claims 4, 10, 13, 15, 17, 19, and 27 are patentably distinct from Magnusson. The Office Action does not cite another reference besides Magnusson that would motivate one of ordinary skill in the art to modify Magnusson. It is impermissible to use the benefit of hindsight or use the Applicant's specification as a blueprint to reject a claim without specific prior art references. Even if Magnusson were modified as proposed by the Office Action, this still would not teach or suggest all limitations in these claims.

Claim 4 depends indirectly from claim 1. As discussed above, Magnusson does not teach or suggest "detect[ing] when a wireless mobile unit is in a high data rate area," as recited in claim 1. Magnusson also does not teach or suggest "exchang[ing] ... data between said wireless mobile unit and said base station when the processor detects said wireless mobile unit is in said high data rate area and the processor determines a need for exchanging data between the wireless mobile unit and the base station," as recited in claim 1.

The Office Action asserts that "[i]t would have been obvious ... to modify Magnusson, such that said DBO transmits a logon name and password to said BTS to authenticate said wireless mobile unit, to provide authentication of the user via a logon name and password." Office Action, pages 5-6. The Office Action does not cite a reference to support this modification of Magnusson. Even if this were true, such a modification would not make up for the claim elements mentioned above that are not taught or suggested by Magnusson. Accordingly, Applicant respectfully submits that claim 4 is patentably distinct from Magnusson, and request that the rejection of claim 4 be withdrawn.

Claim 10 depends indirectly from claim 6. As discussed above, Magnusson does not teach or suggest "detect[ing] when a wireless mobile unit is in an HDR area," as recited in claim 6. Magnusson also does not teach or suggest "exchang[ing] ... data between said wireless mobile unit and said base station when the wireless mobile unit is in said high data rate area and there is a need for exchanging data between the wireless mobile unit and the base station," as recited in claim 6.

The Office Action asserts that "[i]t would have been obvious ... to modify Magnusson, such that said DBO transmits a logon name and password to said BTS to authenticate said wireless mobile unit, to provide authentication of the user via a logon name and password." Office Action, page 6. Even if this were true, such a modification would not make up for the claim elements mentioned above that are not taught or suggested by Magnusson. Thus, Applicant respectfully submits that claim 10 is patentably distinct from Magnusson.

Claim 13 depends from claim 12. As discussed above, Magnusson does not teach or suggest "detecting when [a] wireless mobile unit is in a high data rate area," as recited in claim 12. Magnusson also does not teach or suggest "exchanging said data between said wireless mobile unit and said base station when said wireless mobile unit is said high data rate area," as recited in claim 12. Page 6 of the Office Action asserts that "[i]t would have been obvious ... to modify Magnusson, such that said DBO transmits a logon name and password to said BTS to authenticate said wireless mobile unit, to provide authentication of the user via a logon name and password." Even if this were true, this proposed modification to Magnusson would not make up for the claim elements mentioned above that are not taught or suggested by Magnusson. Thus, Applicant respectfully submits that claim 13 is patentably distinct from Magnusson.

Claim 15 depends from claim 12. As discussed above, Magnusson does not teach or suggest "detecting when [a] wireless mobile unit is in a high data rate area," as recited in claim 12. Magnusson also does not teach or suggest "exchanging said data between said wireless mobile unit and said base station when said wireless mobile unit is said high data rate area," as recited in claim 12. The Office Action (page 6) asserts that "[i]t would have been obvious ... to modify Magnusson, such that it pings said BTS to detect when said wireless mobile unit is in said HDR area after said invoking and prior to exchanging, to provide means for detecting if the mobile can use HDR services for data transmission." Even if this were true, this proposed modification to Magnusson would not make up for the claim elements mentioned above that are not taught or suggested by Magnusson. Accordingly, Applicant respectfully submits that claim 15 is patentably distinct from Magnusson.

With respect to claim 17, Magnusson does not teach or suggest "detecting when said wireless mobile unit is in a high data rate area." Magnusson also does not teach or suggest "exchanging said data between said wireless mobile unit and said base station when said wireless

mobile unit is in said high data rate area." These differences between claim 17 and Magnusson were discussed above. The Office Action (page 7) asserts that "[i]t would have been obvious ... to modify Magnusson, such that said DBO transmits a logon name and password to said BTS to authenticate said wireless mobile unit, to provide authentication of the user via a logon name and password." Even if this were true, this proposed modification to Magnusson would not make up for the claim elements mentioned above that are not taught or suggested by Magnusson. Accordingly, Applicant respectfully submits that claim 17 is patentably distinct from Magnusson.

Claim 19 depends from claim 17. Accordingly, Applicant respectfully requests that the rejection of claim 19 be withdrawn for at least the same reasons as those presented above for claim 17.

Claim 27 depends from claim 26. As discussed above, Magnusson does not teach or suggest "detecting when a wireless mobile unit is in a high data rate area," as recited in claim 26. Magnusson also does not teach or suggest "exchanging ... data between said wireless mobile unit and said base station when said wireless mobile unit is in said high data rate area," as recited in claim 26. The Office Action (page 8) asserts that "[i]t would have been obvious ... to modify Magnusson, such that said DBO transmits a logon name and password to said BTS to authenticate said wireless mobile unit, to provide authentication of the user via a logon name and password." Even if this were true, such a modification would not make up for the claim elements mentioned above that are not taught or suggested by Magnusson. Accordingly, Applicant respectfully submits that claim 27 is patentably distinct from Magnusson.

REQUEST FOR ALLOWANCE

In view of the foregoing amendments and remarks, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

Dated: December 17, 2004

By: _____ACC_____

Alex C. Chen, Reg. No. 45,591

(858) 651-5363

QUALCOMM Incorporated
5775 Morehouse Drive
San Diego, California 92121
Telephone: (858) 651-4125
Facsimile: (858) 658-2502